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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,947	08/09/2000	Morten Nyborg	1359-00	3879

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SCHNADER HARRISON SEGAL & LEWIS, LLP
1600 MARKET STREET
SUITE 3600
PHILADELPHIA, PA 19103

EXAMINER	
NGUYEN, BINH AN DUC	
ART UNIT	**PAPER NUMBER**
3713	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/601,947	NYBORG, MORTEN	
	Examiner	Art Unit	
	Binh-An D. Nguyen	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33,35,37-40,42 and 45-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33,35,37-40,42 and 45-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Request for Continued Examination filed February 18, 2005 has been approved. Further, the substitute claims filed March 18 have been received. According to the Amendment, claims 1-32, 34, 36, 41, 43, and 44 have been canceled; claims 3, 39, 40, 42, 45, 47, and 48 have been amended; and new claims 49 and 50 have been added. Currently, claims 33, 35, 37-40, 42, and 45-50 are pending in the application. Acknowledgment has been made.

2. In claim 33, line 6, the comma (,) before the semicolon (;) should be deleted.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 is indefinite since it depends on the canceled claim 36. Note, it appears that claim 37 should depend on claim 33.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 33, 35, 37-40, 42, and 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Llenas et al. (5,271,626) in view of Katz et al. (5,109,404).

Regarding claims 33 and 40, Llenas et al. teaches a system and method for announcing key codes (game clues) to TV viewers via the screen of their TV set in establishing contact between selected viewers and an established game program over a telecommunications network (Figs. 5a-7) comprising: a key code generator (40, 74, 100) for generating key code (game clues) to include a plurality of descriptive elements (5:13-27; 7:42-45), the key code being selected randomly and automatically among a predetermined number of different key codes (4:34-54) through use of an automatically operating selecting device (code generator 40, 74, 100)(Figs. 3, 5b,7); a key code transmitter for transmitting the key code in succession to the TV screens within a plurality of selected time slots located within a plurality of selected time units between a start and an end of a TV transmission which is at least one of a TV program and a TV commercial spot (4:26-66 and 8:24-41); said key code generator being configured to communicate with a time slot generator to select at random within a time unit at least one of a duration of a time slot and a position of a time slot (processor 100 generates time slot to insert key code to be transmitted, 8:4-23); a line connector for connection of viewers to the game program who by using the key code manage to establish the contact (3:47-59).

Llenas et al. does not explicitly teach the limitation of providing access (or means thereto) to the game program by a predetermined number of viewers who use the key

code are first to establish said contact with the game program (claims 33 and 40). Katz et al., however, teaches a telecommunication network for playing game which controls the number of calls made to the central net work to prevent call over load by declining connection when a certain percentage of incoming call is reached (2:51-68; 3:57-4:32; 5:45-6:7; 8:12-20 and Figures 1-2). Since a telephone network can handle so much incoming calls, would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the television game of Llenas with the method of controlling call routing, as taught by Katz et al., to come up with a telecommunication game network that provides a more reliable access to the network game thus attract both television viewers and game players and increase advertising profit.

Regarding claims 35 and 42, Llenas discloses the time slot generator (100) provides for an automatically operating time slot selection (8:4-23).

Regarding claims 38 and 45, Llenas discloses viewer connection is made via one or more selected from the group consisting of a telephone network (Fig. 4a).

Regarding claims 39, 46, and 47, Llenas discloses the descriptive elements each comprises one or more selected from the group consisting of symbols, numbers, and letters (Fig. 4a). Note that, the applicant's disclosed key codes which "can be made up completely or partially of, e.g., digits in a telephone number, symbols, letters or combination thereof" (applicant's disclosure, page 3, lines 16-17) are equivalent to Llenas et al.'s clues which comprise letters and digits (3:47-59 and Figures 4a).

Regarding claims 49 and 50, Llenas discloses an integrated key code and time generator (40, 74, 100)(Figs. 3, 5b, 7) to automatically determine time units within which key code elements of a key code are to appear during a TV transmission (8:4-23).

7. Applicant's arguments filed February 18, 2005 have been fully considered but they are not persuasive.

Applicant's arguments that Llenas does not disclose non-manual selection of a key code (Applicant's remarks, page 7, second paragraph) is deemed not to be persuasive.

Llenas et al. does teach a key code generator (40, 74, 100) for generating key code (game clues) to include a plurality of descriptive elements (5:13-27; 7:42-45), the key code being selected randomly and automatically among a predetermined number of different key codes (4:34-54) through use of an automatically operating selecting device (code generator 40, 74, 100)(Figs. 3, 5b, 7).

Applicant's arguments that Katz does not disclose providing limiting access to a game program by a predetermined number of viewers (Applicant's remarks, page 6) is deemed not to be persuasive. Katz reference does disclose limiting a predetermined percentage of callers to connect to a phone network (5:45-6:23; 8:12-20).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Llenas et al. teaches a system and method for announcing key codes (game clues) to TV viewers via the screen of their TV set in establishing contact between selected viewers and an established game program over a telecommunications network (Figs. 5a-7); and Katz et teaches a telecommunication network for playing game which controls the number of calls made to the central net work to prevent call over load by declining connection when a certain percentage of incoming call is reached (2:51-68; 3:57-4:32; 5:45-6:7; 8:12-20 and Figures 1-2). Since a telephone network can handle so much incoming calls, would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the television game of Llenas with the method of controlling call routing, as taught by Katz et al., to come up with a telecommunication game network that provides a more reliable access to the network game thus attract both television viewers and game players and increase advertising profit.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 571-272-4440. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BN

XUAN M. THAI
SUPERVISORY PATENT EXAMINER
TC3700